

REMARKS

Upon entry of this amendment, claims 1-3, 5, 14, and 19-22 will be pending in the application. The Examiner has withdrawn claims 6-13, 17, and 18 from consideration as being drawn to a non-elected invention. By this amendment, claims 1, 5, 14, and 21 are amended for the Examiner's consideration, and claims 4, 6-13, and 15-18 are canceled without prejudice or disclaimer. The above amendments do not add new matter to the application and are fully supported by the original disclosure. For example, support for the amendments is provided at lines 6-9 of page 4 of the specification. Applicants reserve the right to file the subject matter of one or more of the canceled claims in one or more continuing applications. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Interview Summary

Applicants thank Examiner Edwards for the courtesy extended during a telephone interview between the Examiner and Applicants' representative on December 17, 2007. In the interview, the Advisory Action dated November 19, 2007 ("Advisory Action") was discussed. The Examiner indicated that amending claim 21 to replace the phrase "at least one paper free layer" with "a paper free layer" would overcome the new matter rejection of claim 21. The Examiner also indicated that Applicants' previous arguments with respect to claim 21, in combination with the amendment regarding "a paper free layer," appears to distinguish claim 21 from the applied art. Thus, it was agreed that amending claim 1 as presented in the response dated October 31, 2007, canceling the withdrawn claims, and amending claim 21 as described above would likely place the application in condition for allowance, pending an updated search.

Amendment is Proper for Entry

Applicants submit that the instant amendment is proper for entry because the amendment places the application in condition for allowance. More specifically, claim 1 is amended to incorporate the subject matter of indicated allowable claim 4. Additionally, the withdrawn claims are canceled. Thus, these amendments clearly do not raise new issues that would require further search or consideration.

Moreover, claim 21 is amended to overcome the new matter rejection under 35 U.S.C. §112, first paragraph. As implied in the Advisory Action and as discussed in the Telephone Interview, Applicants arguments below presumably traverse the prior art rejection of claims 21 and 22. Thus, the amendment to claim 21 has also already been considered by the Examiner, such that it does not raise new issues.

Alternatively, Applicants submit that the instant amendment places the application in better form for appeal by reducing the issues for appeal.

Allowed Claims

Applicants appreciate the indication that claims 4, 5, and 14-16 contain allowable subject matter. By this amendment, claim 4 is written in independent form by amending claim 1 to incorporate the features of claim 4 and canceling claim 4. Therefore, claim 1 should be allowed, as should claims 2, 3, 5, 14, 19, and 20, which depend from claim 1. Moreover, Applicants submit that all of the pending claims are in condition for allowance for the following reasons.

Objection to Specification

The specification is objected to for failing to provide support for the recitation “at least one paper free layer...” in claim 21. This objection is respectfully traversed.

By this response, claim 21 has been amended such that it no longer recites “at least one paper free layer.” Thus the objection is moot. In any event, claim 21 now recites “a paper free layer,” which the Examiner indicated would overcome the new matter rejection of claim 21. Thus, this amendment should also successfully traverse the objection to the specification.

Accordingly, Applicants respectfully request that the objection to the specification be withdrawn.

35 U.S.C. §112 Rejection, First Paragraph

Claims 21 and 22 are rejected under 35 U.S.C. §112, first paragraph. The Examiner maintains the assertion that the recitation “at least one paper free layer of a transparent synthetic resin” is not supported by the written description (i.e., introduces new matter to the claims). This rejection is respectfully traversed.

Without acquiescing in the assertion of the rejection, Applicants have amended claim 21 for clarification purposes to recite “a paper free layer” instead of a “at least one paper free layer.” The Examiner indicated in both the Advisory Action and the Telephone Interview that such an amendment would overcome the 35 U.S.C. §112, first paragraph, rejection of claims 21 and 22. Therefore, the rejection is moot.

Accordingly, Applicants respectfully request that the §112, first paragraph, rejection of claims 21 and 22 be withdrawn.

35 U.S.C. §102(a or e) Rejection

Claims 1-3 and 19-22 are rejected under 35 U.S.C. §102(a or e) as being anticipated by U.S. Patent No. 6,568,148 issued to Eisermann (“Eisermann”) alone or optionally taken with U.S. Pat. No. 7,171,998 issued to Vogel or U.S. Patent No. 5,882,569 issued to Maes (“Maes”). This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131. Applicants submit that the applied art does not show each and every feature of the claimed invention.

Claims 1-3, 19, and 20

By this amendment, claim 1 is amended to incorporate the subject matter of allowable claim 4. Therefore, claim 1, and claims 2, 3, 19, and 20 that depend from claim 1, should be allowed. As such, the §102 rejection of claims 1-3, 19 and 20 is moot.

Claims 21 and 22

The present invention relates to floor panels. In non-limiting exemplary embodiments of the invention, a support board has a decoration printed onto its top side, thereby avoiding the problems associated with printing the decoration on paper and then attaching the paper to the support board. More specifically, independent claim 21 recites a decoration is printed directly onto the top side of the support board and is covered by a paper free layer of a transparent synthetic resin. As discussed in the Telephone Interview on December 17, 2007, Applicants submit that Eisermann does not disclose the combination of (1) a decoration is printed directly onto the top side of the support board and (2) the decoration is covered by a paper free layer of a

transparent synthetic resin. This is because Eisermann only discloses resin layers that include paper.

More specifically, each embodiment disclosed by Eisermann comprises a support plate 5, upper face sheet 2, and lower face sheet 6. The lower face sheet 6 includes resin layer 14 and tension layer 13, which Eisermann explicitly discloses is made of paper (col. 4, lines 22-23). Also, the upper face sheet 2 includes resin layer 9 and support layer 7 that consists essentially of cellulose (col. 4, lines 56-57), which the skilled artisan will recognize as a paper layer. Thus, each resin layer (9 or 14) includes a paper layer (7 or 13). As such, Eisermann does not disclose a resin layer that is paper free, and cannot arguably be said to disclose a decoration is printed directly onto the top side of the support board and is covered by a paper free layer of a transparent synthetic resin, as recited in claim 21.

Claim 21 also recites that the decoration is printed directly onto the top side of the support board. In the Response to Arguments section of the Office Action, the Examiner asserts that Eisermann discloses this feature at FIG. 1 and claims 6, 8, and 9 (Final Office Action, page 3). Applicant respectfully disagree, and submit that these identified portions of Eisermann do not disclose that the decoration is printed directly onto the top side of the support board. For example, claim 6 recites the decorative layer is applied to one of the bottom surface of the support layer (7) or the bottom surface of the upper face sheet (2). The support layer 7 and face sheet 2 are not the support board; therefore, claim 6 does not disclose that the decoration is printed directly onto the top side of the support board. Claims 8 and 9 depend from claim 6 and, by definition, contain the same recitation regarding where the decoration is printed (i.e., on either the support layer 7 or the face sheet 2).

Moreover, FIG. 1 shows a prior art board in which the decorative layer 4 is applied to layer 10, which is made of paper (col. 4, lines 11-14). Layer 10 is not the support board; therefore, FIG. 1 does not disclose that the decoration is printed directly onto the top side of the support board.

For all of the above-discussed reasons, Applicants submit that Eisermann does not disclose all of the features of independent claim 21. Therefore, the rejection of claim 21 is improper and should be withdrawn.

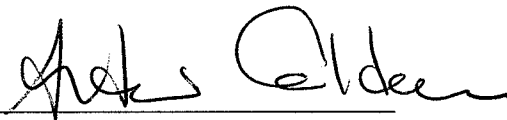
Claim 22 depends from allowable base claim 21, and is distinguishable from the applied art at least for the reasons discussed above with respect to claim 21.

Accordingly, Applicants respectfully request that the §102(a or e) rejection of claims 1-3 and 19-22 be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,
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